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| 10/037,284 | 01/03/2002 | Peter Kotsinadelis | 4366-47 | 6822 |

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| Douglas W. Swartz | | WOZNIAK, JAMES S |
| SHERIDAN ROSS P.C. | | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2655 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/037,284 | KOTSINADELIS, PETER |
| | Examiner | Art Unit | |
| | James S. Wozniak | 2655 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _22 March 2005_.

2a)☒ This action is **FINAL**.     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _38-74_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _38-74_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _1/31/2002_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1.      In response to the office action from 12/22/2004, the applicant has submitted an

amendment, filed 3/22/2004, canceling claims 1-37 and adding new claims 38-74, while arguing

to traverse the art rejection based on the limitations of the new independent claims (38, 51, and

62) *(Amendment, Pages 12-13)*. The applicant's arguments have been fully considered but are

moot with respect to the new grounds of rejection that was necessitated by the newly added

claims.

### *Claim Objections*

2.      **Claims 43 and 67** are objected to because of the following informalities:

With respect to **Claim 43**, "Steps (g) and (h)" should be changed to –Steps (f) and (g)--.

With respect to **Claim 67**, "Operations (g) and (h)" should be changed to –Operations (f)

and (g)--.

Appropriate correction is required.

3.      **Claims 49 and 50** are objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim.  Applicant is required to

cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or

rewrite the claim(s) in independent form.

4.      The infringement test for determining a proper dependent claim as per the MPEP 608.01

(n), Section III, states that a such a claim cannot conceivably be infringed by anything that would

not also infringe the claim it references.  In this case, an apparatus would not infringe the method

steps of Claim 38, since the apparatus itself never actually performs any of the active steps

required by Claim 38.  In other words *possession* of such an apparatus would infringe Claim 49,

but not Claim 38.

        Thus, Claim 49 is an improper dependent claim.

5.      The infringement test for determining a proper dependent claim as per the MPEP 608.01

(n), Section III, states that a such a claim cannot conceivably be infringed by anything that would

not also infringe the claim it references.  In this case, a computer memory medium would not

infringe the method steps of Claim 38, since the memory medium *itself* never actually performs

any of the active steps required by Claim 38.  In other words *possession* of such a memory

medium would infringe Claim 50, but not Claim 38.

        Thus, Claim 50 is an improper dependent claim.


*Claim Rejections - 35 USC § 112*


6.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

        The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
        subject matter which the applicant regards as his invention.

7.    **Claims 48, 51, and 72** are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding **claims 48, 51, and 72**, the term "substantially" renders the claim indefinite

because the specification provides no standard or specific meaning for the degree intended by the

term "substantially." See MPEP § 2173.05(b).

## *Claim Rejections - 35 USC § 102*

8.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign
country or in public use or on sale in this country, more than one year prior to the date of
application for patent in the United States.

9.    **Claims 38-40, 43, and 49** are rejected under 35 U.S.C. 102(b) as being anticipated by

Peck et al *(U.S. Patent: 5,748,843)*.

With respect to **Claim 38**, Peck discloses:

Receiving at least a first voice command *(Col. 12, Lines 34-37)*;

Determining whether the at least a first voice command corresponds to a

macroinstruction having a respective set of instructions *(macro detection, Col. 11, Line 65- Col.*

*13, Line 7)*;

When the at least a first voice command corresponds to a macroinstruction, executing the

respective set of instructions, the respective set of instructions corresponding to a plurality of

further voice commands *(Col. 12, Line 25- Col. 13, Line 7);*

When the at least a first voice command does not correspond to a macroinstruction,

determining whether the at least a first voice command corresponds to a non-macroinstruction

*(Col. 11, Line 65- Col. 12, Line 54);*

When the at least a first voice command corresponds to a non-macroinstruction,

executing the non-macroinstruction *(Col. 11, Line 65- Col. 12, Line 54).*

With respect to **Claim 39**, Peck recites:

Determining if the at least a first voice command corresponds to at least one of creating a

macroinstruction, editing a macroinstruction, and deleting a macroinstruction *(learn mode, Col.*

*12, Lines 32-54);*

When the at least a first voice command corresponds to the at least one of creating a

macroinstruction, editing a macroinstruction, and deleting a macroinstruction, executing at least

one of creating a macroinstruction, editing a macroinstruction, and deleting a macroinstruction

*(learn mode, Col. 12, Lines 32-54).*

With respect to **Claim 40**, Peck discloses:

Requesting the user to pronounce a name for the new macroinstruction to be created

*(recognition computer looking for a macro name which would require an inherent request, Col.*

*12, Lines 32-54, and Fig. 6, Element 78);*

Receiving from the user the pronounced name for the new macroinstruction and the set of

voice commands and associated instructions to be included with the macroinstructions associated

set of instructions *(Col. 12, Lines 32-54)*.

With respect to **Claim 43**, Peck teaches the process of creating a voice command when it

is determined that a voice input is a "learn" command and not a voice macro before the steps of

executing a macro, as applied to Claims 38 and 39.

With respect to **Claim 49**, Peck teaches a speech macro recognition system as shown in

Figs. 2-3.

### *Claim Rejections - 35 USC § 103*

10.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.    **Claim 41** is rejected under 35 U.S.C. 103(a) as being unpatentable over Peck et al in

view of Fitzpatrick et al (U.S. Patent: 5,671,328).

With respect to **Claim 41**, Peck teaches the method for creating a voice macro as applied

to Claim 39. Peck further teaches a prompt that requests a user speak a command for editing

*(Col. 18, Lines 7-18)* and the ability to edit voice macros *(Col. 22, Lines 47-53)*. Peck does not

specifically suggest a specific process of macro editing that includes accessing corresponding

instructions and deleting user commands, however Fitzpatrick discloses a means for accessing

macroinstructions associated with a selected voice command and entering and deleting voice commands *(Col. 6, Line 42- Col. 7, Line 27)*.

Peck and Fitzpatrick are analogous art because they are from a similar field of endeavor in systems utilizing voice commands corresponding to macros. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Peck with the voice macro editing means taught by Fitzpatrick to allow a user to customize a voice recognition macro by modifying a recognition template *(Fitzpatrick, Col. 3, Lines 22-28)*.

12. **Claims 42, 45, 48, 50-54, 56, 58, 61-64, 66-67, 69, and 72** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peck et al in view of Johnson *(U.S. Patent: 5,835,571)*.

With respect to **Claim 42**, Peck teaches the method for creating a voice macro as applied to Claim 40. Peck does not specifically suggest the ability to delete a macro by speaking the name of the macro to be deleted; however Johnson discloses a means for deleting a macro by its voice command *(Col. 12, Lines 31-50; Fig. 7F, Elements 725 and 727)*.

Peck and Johnson are analogous art because they are from a similar field of endeavor in systems utilizing voice commands corresponding to macros. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Peck · with the means for deleting a macro by its voice command as taught by Johnson in order to provide a means for efficiently managing created voice macros *(Johnson, Col. 3, Lines 45-47)*.

With respect to **Claim 45**, Johnson further teaches a graphical user interface that enables the editing of a macro *(Col. 13, Lines 50-58)*.

With respect to **Claim 48**, Johnson further teaches macroinstructions performed immediately after reception of a macro command *(Col. 6, Lines 43-47)*.

With respect to **Claim 50**, Johnson further teaches voice macro method implementation as a program on a computer readable medium *(Col. 5, Lines 55-60)*.

With respect to **Claim 51**, Peck discloses:

Receiving at least a first voice command *(Col. 12, Lines 34-37)*;

Determining whether the at least a first voice command corresponds to a macroinstruction having a respective set of instructions *(macro detection, Col. 11, Line 65- Col. 13, Line 7)*;

When the at least a first voice command corresponds to a macroinstruction, executing the respective set of instructions, the respective set of instructions corresponding to a plurality of further voice commands *(Col. 12, Line 25- Col. 13, Line 7)*;

Peck also teaches a speech recognizer and a voice macro memory *(Col. 12, Lines 32-54)*.

Peck does not specifically suggest voice macro use with a telecommunications switching system, however Johnson teaches such an implementation *(voice macros, Col. 11, Lines 37-57, and PBX switch, Col. 2, Lines 44-48)*. Johnson also teaches macroinstructions performed immediately after reception of a macro command *(Col. 6, Lines 43-47)*.

Peck and Johnson are analogous art because they are from a similar field of endeavor in systems utilizing voice commands corresponding to macros. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Peck with the use of a telecommunications switch as taught by Johnson in order to implement the

system taught by Peck in a telecommunications system that allows different user to share and

manage voice macros over a telephone *(Johnson, Col. 2, Lines 44-49; and Col. 3, Lines 45-47)*.

**Claims 52-54** contain subject matter similar to Claims 38-40, and thus, are rejected for

the same reasons.

**Claim 56** contains subject matter similar to Claim 42, and thus, is rejected for the same

reasons.

**Claims 58 and 69** contain subject matter similar to Claim 45, and thus, are rejected for

the same reasons.

With respect to **Claim 61**, Peck teaches the input of user speech for commands within a

macro as applied to Claim 40.

**Claim 62** contains subject matter similar to Claims 51 and 52, and thus, is rejected for the

same reasons.

**Claims 63-64** contain subject matter similar to Claims 39-40, and thus, are rejected for

the same reasons.

**Claims 66-67** contain subject matter similar to Claims 42-43, and thus, are rejected for

the same reasons.

With respect to **Claim 72**, Johnson further teaches macroinstructions performed

immediately after reception of a macro command *(Col. 6, Lines 43-47)*.


13.    **Claims 44, 46, and 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Peck et al in view of Davis *(U.S. Patent: 6,816,837)*.

With respect to **Claim 44**, Peck teaches the speech recognition method utilizing voice macros as applied to Claim 38. Peck does not specifically suggest a first voice command corresponding to a first macroinstruction and a second macroinstruction that is related to the first, whereby to invoke the second macroinstruction the first macroinstruction the first voice command must be spoken, however Davis teaches a voice command macro for optical character recognition that corresponds to scanning a document to recognize text. Davis teaches a first instruction within a macro for scanning and a related second instruction involving character settings that cannot be invoked unless an "OCR" command is issued by a user *(Col. 2, Lines 21-41)*.

Peck and Davis are analogous art because they are from a similar field of endeavor in speech-controlled systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Peck with the example of voice command macroinstructions taught by Davis in order to implement voice macro control of a practical capture device without having to repeat the same set of voice command instructions *(Davis, Col. 1, Lines 25-39; Col. 1, Lines 51-55)*.

With respect to **Claim 46**, Peck teaches the method for creating a voice macro as applied to Claim 40. Peck does not specifically suggest the use of a graphical user interface to create a voice macro, however Davis teaches a system and method for voice macro creation that allows entry of a voice macro through a computer having a graphical user interface by speaking the macro speech commands and the name of the macro *(Col. 4, Line 59- Col. 5, Line 49)*.

Peck and Davis are analogous art because they are from a similar field of endeavor in speech-controlled systems. Thus, it would have been obvious to a person of ordinary skill in the

art, at the time of invention, to modify the teachings of Peck with the graphical user interface

enabling the creation of voice macros as taught by Davis to provide a convenient means of

indicating to a user whether an input speech command that is to be part of a macro is properly

recognized *(Davis, Col. 9, Lines 4-10)*.

With respect to **Claim 47**, Davis further teaches the creation of a voice macro in an order

of execution *(creation of macros, Col. 5, Lines 23-49; and macro creation example, Col. 2, Lines

21-41)* and executing an entire set of commands corresponding to a voice macro *(Col. 11, Lines

9-12; Fig. 8, Element 818)*.

14.      **Claims 55 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peck et

al in view of Johnson, and further in view of Fitzpatrick et al.

With respect to **Claims 55 and 65**, Peck in view of Johnson teaches the speech

recognition system utilizing voice macros as applied to Claims 53 and 63. Peck in view of

Johnson does not specifically suggest a specific process of macro editing that includes accessing

corresponding instructions and deleting user commands, however Fitzpatrick discloses a means

for accessing macroinstructions associated with a selected voice command and entering and

deleting voice commands *(Col. 6, Line 42- Col. 7, Line 27)*.

Peck, Johnson, and Fitzpatrick are analogous art because they are from a similar field of

endeavor in systems utilizing voice commands corresponding to macros. Thus, it would have

been obvious to a person of ordinary skill in the art, at the time of invention, to modify the

teachings of Peck in view of Johnson with the voice macro editing means taught by Fitzpatrick to

allow a user to customize a voice recognition macro by modifying a recognition template *(Fitzpatrick, Col. 3, Lines 22-28)*.

15.    **Claims 57, 59-60, 68, 70, and 71** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peck et al in view of Johnson, and further in view of Davis.

With respect to **Claim 57**, Peck in view of Johnson teaches the speech recognition system utilizing voice macros as applied to Claim 53. Peck in view of Johnson does not specifically suggest a first voice command corresponding to a first macroinstruction and a second macroinstruction that is related to the first, whereby to invoke the second macroinstruction the first macroinstruction the first voice command must be spoken, however Davis teaches a voice command macro for optical character recognition that corresponds to scanning a document to recognize text. Davis teaches a first instruction within a macro for scanning and a related second instruction involving character settings that cannot be invoked unless an "OCR" command is issued by a user *(Col. 2, Lines 21-41)*.

Peck, Johnson, and Davis are analogous art because they are from a similar field of endeavor in systems utilizing voice commands corresponding to macros. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Peck in view of Johnson with the example of voice command macroinstructions taught by Davis in order to implement voice macro control of a practical capture device without having to repeat the same set of voice command instructions *(Davis, Col. 1, Lines 25-39; Col. 1, Lines 51-55)*.

**Claims 59 and 70** contain subject matter similar to Claim 46, and thus, are rejected for the same reasons.

**Claims 60 and 71** contain subject matter similar to Claim 47, and thus, are rejected for the same reasons.

**Claim 68** contains subject matter similar to Claim 57, and thus, is rejected for the same reasons.

16.    **Claims 73-74** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peck et al in view of Johnson, and further in view of Hashimoto et al *(U.S. Patent: 5,632,002)*.

With respect to **Claim 73**, Peck in view of Johnson teaches the voice recognition unit, macrolibrary, and switching system as applied to Claim 51. Peck in view of Johnson does not specifically suggest speech macro use in a voice messaging system, however Hashimoto discloses such an implementation *(Col. 37, Lines 25-54; Fig. 53; and speech macros, Col. 38, Lines 56-67)*.

Peck, Johnson, and Hashimoto are analogous art because they are from a similar field of endeavor in systems utilizing voice commands corresponding to macros. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Peck in view of Johnson with the voice mail system taught by Hashimoto in order to implement user created macros in a practical and well-known voice mail application in order to facilitate more efficient voice mail retrieval searches *(Hashimoto, Col. 38, Lines 56-67)*.

With respect to **Claim 74**, Hashimoto teaches macros associated with voice mail retrieval searches *(Col. 38, Lines 56-67)*.

## *Conclusion*

17.    Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.  In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

18.    The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

Frulla et al *(U.S. Patent:  6,424,357)-* teaches a system that enables the creation of voice

macros.

19.    Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James S. Wozniak whose telephone number is (571) 272-7632

and email is James.Wozniak@uspto.gov. The examiner can normally be reached on Mondays-

Fridays, 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wayne Young can be reached at (571) 272-7582. The fax/phone number for the

Technology Center 2600 where this application is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the technology center receptionist whose telephone number is (703) 306-

0377.

James S. Wozniak
6/6/2005

SUSAN MCFADDEN
PRIMARY EXAMINER